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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,408	02/07/2000	SIEGFRIED WILHELM	2345/115	1878
26646	7590	05/31/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			ARANI, TAGHI T	
			ART UNIT	PAPER NUMBER
			2131	
DATE MAILED: 05/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/485,408

Applicant(s)

WILHELM ET AL.

Examiner

Taghi T. Arani

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. Claims 15-21 have been examined and are pending.

### Response to Arguments

2. Applicant's arguments filed March 10, 2005 regarding the rejection of the claims 15-21 under Applicant merely argues lack of a motive to combine the reference.

The Applicant (page 9 of the REMARKS) cites a portion of the Federal Circuit in the case of *In re Kotzab* and incorrectly concludes that "[T] here must be some finding as to the specific understanding of principle within the knowledge of a skilled artisan that would motivate a person having no knowledge of the claimed subject matter to make the combination in the manner claimed", emphasis added by the Examiner.

The Federal Circuit in the case of *In re Kotzab* states:

"But, there was no findings as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed." emphasis added by the Examiner. No knowledge of invention in the case was stated not the subject matter as it is incorrectly stated by the Applicant.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Therefor , the Examiner maintains the rejections of claims 15-21.

***Claim Rejections - 35 USC § 103***

The following is a quota on of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art of record, U.S. Patent No. 5,534,913 to Majeti et al. in view of U.S. Patent No. 5,029,207 to Gammie.

Referring to claim 15, Majeti et al. teach a decoder device for decrypting encrypted television programs, the decoder device comprising;

a control unit [figure 4, HOME CONTROLLER 122];

a second interface for interfacing to the control unit [figure 5, 132];

a third interface for interfacing to a telecommunications network [column 3, lines 59-67].

Majeti et al do not teach decoder device for decrypting encrypted television programs, the decoder device comprising:

an input for receiving the encrypted television program;

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a decryption device for decrypting the encrypted television program into a format reproducible by a television set:

an output capable of being connected to the television set so as to output the decrypted television program to the television set for reproduction;

a first interface for interfacing to at least one of a first identification and a first key carrier component for enabling the decryption device, the first interface being disposed in the control unit; and

a fourth interface for interfacing to at least one of a second identification and a second key carrier component, an authorization by at least one of the second identification and the second key carrier component being useable for establishing a connection to a subscriber via the communications network.

However, Gammie discloses a decoder device comprising:

an input for receiving the encrypted television program [figure 5, SATELLITE LINK 505];

a decryption device for decrypting the encrypted television program into a format reproducible by a television set [figure 5, PROGRAM DESCRAMBLER 508];

an output capable of being connected to the television set so as to output the decrypted television program to the television set for reproduction [figure 5, OUTPUT 509];

a first interface for interfacing to at least one of a first identification and a first key carrier component for enabling the decryption device, the first interface being disposed in the control unit [figure 5, replaceable security module 514]; and

a fourth interface for interfacing to at least one of a second identification and a second key carrier component, An authorization by at least one of the second identification and the second key carrier component being useable for establishing a connection to a subscriber via the communications network [figure 5, replaceable security module 514 and column 6, lines 49-53].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Gammie's teachings of decrypting the received programs for a conditional access television system to the system and method of Majeti et al. such that Majeti et al.'s system could include a smart card reader in the HOME CONTROLLER for reading decryptor, keys/identification from smart cards. The decryption keys would then be sent to the decryption device newly placed in the set top box. One would have been motivated to modify Majeti et al.'s system as such in order to provide higher security for the transmitted program information [column 6, lines 48-50]

Referring to claim 16, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the fourth interface is disposed in the control unit [figure 5, replaceable security module 514 and column 6, lines 49-53].

Referring to claim 17, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the television set includes a fifth interface for receiving control commands and wherein the control unit is capable of controlling the television set [column 12, line 37-column 13, line 3].

Referring to claim 18, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the first and the second identification and/or key carrier components include a respective smart card or a common smart card [column 11, lines 63-65 to Gammie].

Referring to claim 19, Majeti et al. as modified teach the decoder device as recited in claim 15 further comprising a sixth interface for connecting the decoder device to a computer [figure 1, 72 to Majeti], the computer being adaptable for at least one of controlling the decoder device and establishing a connection to a subscriber via the telecommunications network (figure 1 MODEM 76).

Referring to claim 20, Majeti et al. as modified teach the decoder device as recited in claim 15 wherein the control unit includes a computer, the computer including a seventh interface for controlling the decoder device and including the first and fourth interfaces [figure 1, PERSONAL COMPUTER 74 and HOME CONTROLLER 70].

Referring to claim 21, Majeti et al. as modified teach all limitations of claim 21 except for the limitation of the decoder device is integrated in the television set.

However Gammie discloses the decoder device is integrated in the television set [column 6, line 26-28 of Gammie].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Gammie's teachings of integrating the decoder into the television set to the system and method of Majeti et al. One would have been motivated to modify Majeti et al.'s system as such in order to make for a more compact unit [column 6, lines 26-28].

**Action is Final**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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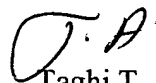
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.  
Examiner  
Art Unit 2131



AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100